

Hanak, Administrative Trademark Judge, dissenting:

I respectfully dissent. The record establishes that the Sierra Club is a very famous organization which has been in existence for well over 100 years. Indeed, opposer Sierra argues that the fame of the Sierra Club is so great that said fame actually "increases the likelihood of confusion because consumers may think that Sierra's goods are associated with Sierra Club." (Opposer's reply brief page 14).

Because the Sierra Club is so very famous, it is my opinion that when its mark SIERRA CLUB appears on screen savers, consumers will be able to distinguish these screen savers from screen savers bearing opposer's mark SIERRA per se. The word "club" is a vital part of both applicant's very famous trade name and its trademark for screen savers. I simply do not share the view of the majority that "the marks SIERRA and SIERRA CLUB [for screen savers] create very similar overall commercial impressions" because "both are dominated by the same word SIERRA." (Majority page 13). It is common knowledge that the Sierra Club has received widespread publicity regarding its efforts to protect the environment through legal action, education and other means. American consumers are quite accustomed to hearing news reports referring to the Sierra Club as, for

example, "initiating action in Federal Court in San Francisco to halt the cutting of redwoods." The record is totally devoid of any evidence showing that the famous Sierra Club has ever been referred to simply as Sierra. Indeed, American consumers would, in my judgment, be quite perplexed by a news story stating that "Sierra has initiated action in Federal Court in San Francisco to halt the cutting of redwoods."

The majority justifies its contention that applicant's mark SIERRA CLUB is dominated by the word SIERRA because "applicant's mark may be readily shortened to SIERRA" as demonstrated by the fact that applicant "owns a registration for the mark SIERRA for its magazine." (Majority page 13). However, nowhere in the record is there a copy of applicant's SIERRA magazine. It may well be the case that while SIERRA is the name of applicant's magazine, that applicant's magazine also features beneath the title SIERRA, in prominent fashion, words to the following effect: "The magazine of the Sierra Club."<sup>1</sup>

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<sup>1</sup> It is recognized that the Sierra Club claims rights in SIERRA per se for its magazine. (Sierra Club brief pages 7 and 11). Contrary to statements in footnote 12, the dissent is not ignoring this claim made by the Sierra Club.

Regardless of the name of applicant's magazine, the fact of the matter is that applicant seeks to register SIERRA CLUB in its entirety for screen savers. Given that the Sierra Club is so very famous (as acknowledged by the opposer), I believe that consumers would readily distinguish the mark SIERRA CLUB from opposer's mark SIERRA per se even when both are used on screen savers.<sup>2</sup>

One final comment is in order. The majority is of the view that that record contains "an instance of reverse confusion," and that while this is the only evidence of "actual confusion," the majority finds that this provides "evidence of the potential for confusion, if not of the normal 'forward confusion' in which applicant's screen savers would be likely to presumed to originate with opposer, at least the less frequently arising 'reverse confusion' in which opposer's screen savers and computer games would be mistakenly associated with applicant."

(Majority page 15).

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<sup>2</sup> At page 13 of its brief, opposer argues that SIERRA is the dominant part of applicant's mark SIERRA CLUB because the word CLUB is descriptive. Two comments are in order. First, the word "club" is certainly not descriptive of the goods for which applicant seeks to register SIERRA CLUB, namely, screen savers. Second, while the word "club" is arguably descriptive of applicant's famous organization known as the Sierra Club, the fact remains that through widespread use spanning well over 100 years, the word "club" has become an intrical component of the name of applicant's organization known as the Sierra Club.

However, a careful review of the record reveals that the incident in question (1) does not reflect any real actual confusion (forward or reverse), and (2) even if it did reflect actual confusion, said actual confusion resulted not from the use of applicant's mark SIERRA CLUB on screen savers, but rather resulted from applicant's rights in its organizational name Sierra Club, which rights predated opposer's first use of SIERRA by well over 90 years.

On December 30, 1995 the Sierra Club received a three page e-mail from a mother who identified herself "as a Sierra Club supporter." Shortly after Christmas, her 13 year old son purchased a computer game which the mother reported to the Sierra Club was "produced by SIERRA, Sierra On-Line Inc., Bellevue, Wa." The mother describes the game as containing "acts of violence and sex" including a depiction of "human intestines being forced down a woman's throat until she died." This mother was in no way under the belief that the Sierra Club produced this game. Rather, she knew very well that it was opposer Sierra On-Line, Inc. which was the source of the game. As the mother stated, the purpose of her of e-mail to the Sierra Club was to "alert/remind the public [and the Sierra Club] with

regards to copy-cat graphics which portray the illusion of your [the Sierra Club's] endorsement."

Clearly, this mother was not confused as to source of a game. Moreover, there is nothing in the e-mail to suggest that her 13 year old son was confused.

It has been noted that even when a consumer inquires as to whether a defendant's product is affiliated with plaintiff (or vice versa), that "the better view" is that such evidence "is insufficient proof of actual confusion."

3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:16 at pages 23-38 to 23-39 (4<sup>th</sup> ed. 1999). In her December 30, 1995 e-mail, the mother was not even making inquiry as to whether opposer's SIERRA computer game originated with the Sierra Club. Rather, she knew full well that it did not, and her purpose in e-mailing the Sierra Club was to alert the Sierra Club as to the "copy-cat graphics [of opposer] which portray the illusion of your [the Sierra Club's] endorsement."

Moreover, even if we assume, as does the majority, that the mother had some brief, initial confusion, such confusion resulted not from the marketing by the Sierra Club of SIERRA CLUB screen savers, but rather it resulted from the extreme fame of the Sierra Club as a highly regarded 100 year old organization, for which the mother

had "loving respect." See footnote 14 of the majority. To the extent that the mother views opposer Sierra On-Line, Inc. as a "copy-cat" because of applicant's long prior use of Sierra Club as the name of its organization, this does not present a cause of action under the trademark laws of this country. See DeCosta v. Viacom International Inc., 981 F.2d 602, 25 USPQ2d 1187, 1193 (1<sup>st</sup> Cir. 1992, Chief Judge, now Justice, Breyer).

One final word of caution is in order. Screen savers are natural promotional items in that they retail for as low as \$5. In recent years, it has been quite common for the owners of famous marks, such as Sierra Club, to license their use on a wide array of promotional items and other products. It is my view that this Board should be very cautious in finding a likelihood of confusion when the owner of a very old and very famous mark expands its use to promotional items based upon the fact that a third-party has previously used and registered a part of that famous mark upon the same or similar item. If this Board finds confusion under such circumstances, the result may well be increased litigation before this Board and the courts when a third party first uses or seeks to register a mark which consists of or contains a part of a famous mark. To give a specific example, in this case opposer first used and

registered SIERRA in the mid 1980s, a time when applicant had already made continuous use of its very famous name and mark SIERRA CLUB for over 90 years. As the e-mail from the concerned mother demonstrates, at least some individuals viewed opposer, because of its use of SIERRA per se on computer games, to be a "copy-cat" of the Sierra Club. The result reached by the majority will only force the owners of famous marks to bring additional proceedings against third parties when the third parties first use portions of the famous marks for fear that if they do not act, they later may well be barred from registering their famous marks in their entirety for goods or services which are identical to or very similar to the goods or services of these third-party newcomers.

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